

REMARKS

Claims 1, 6, 8, 12, 14 - 15, 17 - 18, 20, and 23 have been amended. No new matter has been introduced with these amendments, all of which are supported in the specification as originally filed. Claims 1 - 10, 12 - 20, and 22 - 23 remain in the application.

This Preliminary Amendment responds to the Office Action dated October 20, 2005 (hereinafter, "the Office Action") and to the Advisory Action dated December 13, 2005 (hereinafter, "the Advisory Action").

I. **Rejection under 35 U.S.C. §103**

Paragraph 3 of the Office Action states that Claims 1 - 2, 8 - 9, and 15 - 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 6,415,982 to Bridgelall et al. (hereinafter, "Bridgelall"). Paragraph 4 of the Office Action states that Claims 3 - 7, 10, 12 - 14, 17 - 20, and 22 - 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bridgelall in view of U. S. Patent 6,554,187 to Otto.

Applicant has amended her independent Claims 1, 8, and 15 to clarify that the "at least one items" referenced in the final limitation are the "possessed" items and to use the term "paid for" rather than "presented for purchase" (thereby aligning with the terminology in the final limitation of dependent Claims 3, 10, and 17).

Referring first to independent Claims 1, 8, and 15, Applicant notes that the Office Action

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refers to the shopping tote 86, which *contains items* to be purchased, for teaching the limitation of “storing the customer identifier in an item-identifying RFID tag ...”. This claim language, as amended herein, clarifies that the tag of interest is “affixed to each of at least one items being paid for in a current transaction”. Bridgelall’s shopping tote is not being paid for. Instead, in Bridgelall, items 85 are (presumably) being paid for, and Bridgelall teaches that those items use bar codes 14 (and that a bar code reader 10 is provided on his counter 87; see col. 6, lines 17 - 18). Information cannot be stored into this bar code on items 85, as is well known. Accordingly, it is clear that nothing (and in particular, no customer identifier) is being “stor[ed] ... in an ... RFID tag affixed to each of at least one items being paid for ...” (Claim 1, lines 4 - 5, emphasis added), in contrast to the limitations of Applicants’ Claims 1, 8, and 15.

Furthermore, the Office Action states that Bridgelall’s RFID tag 88 “is capable of subsequently be[ing] searched” (Office Action, p. 3, lines 16 - 17; emphasis added) and “is capable of achieving the claimed use of the item-identifying RFID tag” (Office Action, p. 6, lines 1 - 2; emphasis added). Applicant respectfully notes that what something “is capable of” is not the test for obviousness (and that this suggests prohibited *hindsight* analysis). See Section 706.02(j) of the MPEP, “Contents of a 35 U.S.C. 103 Rejection”, which states the requirements for establishing a *prima facie* case of obviousness under this statute. As noted therein, three criteria must be met. These criteria are (1) a suggestion or motivation, found either in the references or in the knowledge generally available, to modify or combine the references; (2) a reasonable expectation of success; and (3) the combination must teach all the claim limitations. The three requirements for establishing a *prima facie* case of obviousness are also stated in

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MPEP §2142, “Legal Concept of *Prima Facie* Obviousness”, and MPEP §2143, “Basic Requirements of a *Prima Facie* Case of Obviousness”. Bridgelall does not teach storing information into RFID tags of items being paid for, and in particular, does not teach storing a customer identifier therein, and the Office Action fails to provide a proper motivation for modifying the reference.

With regard to the Advisory Action, it is admitted in “Continuation of 11.” therein that Bridgelall’s RFID tag “is on the shopping tote and not a specific item”. It is then stated that Bridgelall’s RFID tags can be used “to track items for purchase, or that are being purchased” and that Bridgelall’s RFID tag “is capable of being searched because the information is indeed stored there” (emphasis added). Applicant respectfully notes that storing a customer identifier in the RFID tag of a shopping tote which may hold items, as discussed by Bridgelall, is patentably distinct from her claimed invention, as will now be discussed.

Suppose, by way of example, that Bridgelall’s shopper presents a shopping tote that holds 3 widgets, and that the shopper then pays for these 3 widgets. Prior to leaving the shopping establishment, the shopper might slip one or more additional widgets into his/her shopping tote, where these additional widgets were not paid for, hoping that the theft of these additional widgets will escape detection. Determining that the RFID tag affixed to the shopping tote contains the shopper’s customer number, as suggested by the Advisory Action, does nothing toward determining whether all the widgets in the shopping tote have been paid for. (In fact, determining that the RFID affixed to the shopping tote contains the shopper’s customer number

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does not indicate anything about whether any items in the shopping tote were paid for.)

Alternatively, Bridgelall's shopper might slip other types of items into his/her shopping tote, along with the paid-for widgets. Still, however, having the customer identifier in the RFID tag of the shopping tote does nothing toward detecting theft of those other items.

By contrast, Applicant's Claims 1, 8, and 15 specify that the customer number is stored into the RFID tag affixed to each item being paid for by a shopper (Claim 1, lines 4 - 5). So, continuing with the example, if the shopper pays for 3 widgets, then the RFID tag of each of those widgets has the shopper's customer identifier stored therein. If the shopper attempts to leave the shopping establishment with 4 or 5 widgets, having only paid for 3 of them, Applicant's Claims 1, 8, and 15 specify that "the item-identifying RFID tag affixed to each of [these 4 or 5 widgets] possessed by the shopper can subsequently be searched to determine whether [the 4 or 5 widgets] were paid for ..." (Claim 1, lines 6 - 8). Claims 3, 10, and 17 further specify (continuing with the example) that the theft of the 1 or 2 widgets is detected by determining that the customer identifier has not been stored in the RFID tags of those items -- that is, "for [the 1 or 2 widgets] for which the customer number is determined not to be previously stored therein [i.e., because the widgets were not paid for, and therefore did not undergo the "storing the customer identifier ..." processing specified in the final limitation of Claims 1, 8, and 15], concluding that [those widgets were] not paid for ..." (Claim 3, lines 6 - 8, emphasis added).

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Applicant therefore respectfully submits that her independent Claims 1, 8, and 15 are clearly patentable over Bridgelall. Dependent Claims 2 - 3, 9 - 10, and 16 - 17 are therefore deemed patentable over Bridgelall by virtue of (at least) the allowability of the independent claims from which they depend.

With regard to independent Claims 4, 12, and 18, neither Bridgelall nor Otto teaches “searching ... an item-identifying RFID tag affixed to [each item possessed by the shopper] to determine whether the customer identifier from the customer loyalty card was previously stored therein [i.e., stored in the item’s RFID tag] during a particular purchase transaction” (Claim 4, lines 4 - 6, emphasis added). The Office Action refers (on p. 4, lines 7 - 12) to Otto’s system 10 and label 12, as well as col. 1 lines 43+ and col. 2, lines 42+. However, Applicant respectfully submits that Otto has no teaching of a customer identifier that was previously read from a customer loyalty card being found (i.e., searched for) in the RFID tag of an item, in contrast to Applicants’ Claims 4, 12, and 18. And, as discussed above with regard to Claims 1, 8, and 15, Bridgelall’s shopping tote with customer identifier stored therein also fails to teach this limitation.

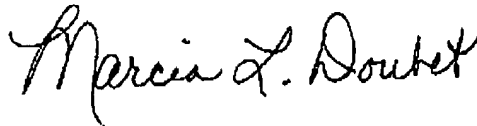
In addition, Otto teaches that “purchase information” is not even checked unless the item is from a different store than the store in which the shopper is presently located. See Fig. 2, where the “Same Store?” test 50 must have a negative response before looking at purchase information 52. See also col. 2, lines 47 - 50.

Thus, independent Claims 4, 12, and 18 are deemed patentable over the references. Dependent Claims 5 - 7, 13 - 14, 19 - 20, and 22 - 23 are therefore deemed patentable over the references by virtue of (at least) the allowability of independent Claims 4, 12, and 18.

II. Conclusion

In conclusion, Applicant respectfully submits that Claims 1 - 10, 12 - 20, and 22 - 23 are patentable over the references. The Examiner is therefore respectfully requested to pass these claims to issuance without further delay. If a phone call to the undersigned is deemed to be useful, such phone call is earnestly solicited.

Respectfully submitted,



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